

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

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| Applicant's or agent's file reference B-4615-WO | FOR FURTHER ACTION See Form PCT/IPEA/416 | |
| International application No. PCT/CH2004/000446 | International filing date (day/month/year) 13.07.2004 | Priority date (day/month/year) 16.07.2003 |
| International Patent Classification (IPC) or national classification and IPC G07F7/00, B41 F21/00 | | |
| Applicant KBA-GIORI S.A. | | |

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 9 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of 6 sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

| | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

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|---|-----------------------------------|
| Date of submission of the demand | Date of completion of this report |
| Name and mailing address of the IPEA/EP | Authorized officer |
| Facsimile No. | Telephone No. |

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International application No.

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Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-16 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* 1-38 _____ received by this Authority on 13.05.2005 with telefax
- nos.* _____ received by this Authority on _____
- ☒ the drawings:
- sheets 1/7-7/7 _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

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|-------------------------------|--------|--------------------|-----|
| Novelty (N) | Claims | <u>1-38</u> | YES |
| | Claims | <u></u> | NO |
| Inventive step (IS) | Claims | <u>36</u> | YES |
| | Claims | <u>1-35, 37-38</u> | NO |
| Industrial applicability (IA) | Claims | <u>1-38</u> | YES |
| | Claims | <u></u> | NO |

2. Citations and explanations (Rule 70.7)

1. The present report makes reference to the following documents:

D1: US-A-3 412 993 (GUALTIERO GIORI)
26 November 1968 (1968-11-26)
D2: DE 199 33 304 A (ROLAND MAN DRUCKMASCH)
25 January 2001 (2001-01-25)
D3: US-A-5 598 006 (STRINGA LUIGI)
28 January 1997 (1997-01-28)
D4: US-A-1514 049 (KOSHIRO ICHIDA)
4 November 1924 (1924-11-04).

2. Inventive step

2.1 Independent claim 1

Document D1, being the closest prior art, discloses a machine for processing sheets of paper, said machine comprising a plurality of modules through which the sheets to be processed pass in succession ("apparatus for checking bank notes after printing and before packaging which includes a source of supply of stacks of notes

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having control colour marks thereon; first counting means (...); transport means for conveying the notes (...) to successive go stations where checking operations are to be performed", column 1, lines 14-21), and having in particular:

- a sheet-feed module for supplying sheets to a downstream sheet-processing module ("feed station 110", column 8, line 23);
- said sheet-processing module additionally comprising [one or more, as required] of the following modules:
 - an inspection module for monitoring the print quality of the sheets ("examination and determination of printing errors", column 8, lines 26-27; column 8, lines 36-60);
 - a marking module for marking a sheet as usable or unusable in accordance with a monitoring report from the inspection module ("numbering unit 124 has a printing cylinder and a numbering cylinder (...)", column 8, lines 72 ff.); and
 - a numbering module for the continuous numbering of the sheets (*ibid*); and
- said modules being so devised that the following machine sub-units can be made assembled as required;

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- a first sub-unit with a sheet-feed module and a numbering module coupled in series;
- a second sub-unit with a sheet-feed module, an inspection module and a numbering module coupled in series; and
- a third sub-unit with a sheet-feed module, an inspection module and a marking module coupled in series.

Figure 6 of document D1 is a diagram showing a sheet-feed module (path from 102 to the cylinder 50), the subsequent inspection module being formed of cylinders 50, 51 and 53 and of units 104a, 104b, 105 and 106, and also of the marking and numbering unit 124. Thus, the three claimed series are known from D1.

Claim 1 differs from D1 in that the sheet-input interface and the sheet-output interface of at least one sheet-processing module can be selectively coupled with sheet-output and sheet-input interfaces of at least two other modules.

The technical effect of this difference is that the different modules are mutually interchangeable and, hence, it is possible to configure a machine as required.

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Thus, the plausible technical problem which can be formulated is that of devising a way in which an installation such as that of D1, can be further developed in order that it can perform different tasks.

Document D2 relates to a feeder unit for sheet-processing machines and would therefore be taken into account by a person skilled in the relevant art seeking to solve the aforementioned plausible technical problem; said expert can see four processing units 14-17 arranged in series in figure 1 of D2. Although said processing units are initially described as being structurally identical (column 3, line 19) document D2 subsequently discloses different embodiments thereof. These differences give rise to different potential uses of the installation (see D2, column 3, lines 32-43) for example, recto printing as opposed to recto and verso printing. Since the processing units are initially described as being structurally identical, a person skilled in the art is left in no doubt that they are mutually interchangeable.

The fact that whole banknotes can be inspected in the installation according to the invention does not contribute to an inventive step, since a person skilled in the art would design the installation on the lines of the sample available

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to him. Whether or not this sample has one or more applications does not pose a problem that a person skilled in the art would not be able to solve without an inventive step. Moreover, this opinion appears to be further supported by D1 (see column 8, lines 39 and 40), in which it is disclosed that the bank notes are not cut until they have been inspected. A person skilled in the art is therefore fully aware of the inspection of sheets that have a plurality of applications.

Thus, proceeding from documents D1 and D2 in combination, a person skilled in the art would arrive at the subject matter of claim 1. Said claim is therefore not inventive (PCT Article 33(3)).

2.2 The remaining dependent claims

The features of the other dependent claims, in so far as they have not been previously disclosed for the same use in the documents cited in the international search report, are known to a person skilled in the art and consequently do not involve an inventive step (PCT Article 33(3)) and, therefore, fail to satisfy the requirements of PCT Article 33(1).

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2.3 Dependent claim 35

The additional feature of claim 35 is known only from D3; thus, it is conceivable, that said subject matter is rendered obvious only by three documents in combination.

With regard to the respective solutions of the two problems, since claim 1 addresses one problem (the solution to which is, in any case, rendered obvious by D2) and claim 35 addresses a quite different problem, namely increasing the reliability of the evaluation device, reference can be made in each case to one further document in addition to D1.

In the light of D1 and D2 in combination with D3, a person skilled in the art would arrive at the subject matter of claim 35. Said claim is therefore not inventive (PCT Article 33(3)).

2.4 Dependent claim 36

The combination of features in claim 36 is neither known from the available prior art nor is it rendered obvious thereby. The reasons are as follows:

the prior art describes a cylinder with a transparent casing, within which is located the

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source of the light that shines through the document to be inspected. The transport means, namely the cylinder, thus also forms part of the unit *per se*, the construction of the device being thereby simplified. This combinatory effect is not described in the available prior art and is therefore non-obvious. Thus, claim 5 satisfies the requirements of PCT Article 33(3).